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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/531,586
Filing Date: April 18, 2005
Appellant(s): REISACHER ET AL.

Teddy S Gron
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 01/25/2009 appealing from the Office action mailed 11/20/2008.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

Claims 7-16 are rejected.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the

subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

4234466	Takahashi et al.	11-1980
5112404	Sommer et al.	5-1992

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 7-8 and 11-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over U. S. patent No. 4,234,466 to Takahashi et al.

Regarding claim 7, Takahashi et al. disclose a solid pigment comprising of 1-70% of pigment (col. 4, lines 9 and 10) and 27-96% at least one ethylenically unsaturated polymerisable compound (col. 3, lines 22 and 23) and 3-60% a resin (col. 3, lines 49 and 50). The references differ from Applicant's recitations of claims by not disclosing identical ranges. However, the reference discloses "overlapping" ranges, and overlapping ranges have been held to establish prima facie obviousness (MPEP 2144.05).

Regarding claims 8 and 11, Takahashi et al. disclose a solid pigment comprising a titanium dioxide pigment having bead particle in the range of 0.1-0.5 mm (col. 8, lines 36 and 37). Although they are silent about the surface area as applicant set forth in claim

2, it is the position of the Examiner that the surface area of a particle is the function of the size and shape of the particle, the claimed surface area would be inherent to of Takahashi et al. See MPEP 2112.

Regarding claim 12, Takahashi et al. disclose an ethylenically unsaturated polymerisable compound, a resin and a pigment mixed by a conventional dispersing machine such as roller mill, a colloid mill, a fluid energy mill, an oscillation ball mill, and ball mill (col. 4, lines 16 – 22) and then dried to obtain solid pigment(Example 1).

Regarding claim 13, Takahashi et al. disclose that the solid pigment is incorporated by stirring (col. 8, line 33).

Regarding claim 14, Takahashi et al. disclose the solid pigment used in a coating composition (col. 8, line 46). Water is used in the process of making solid pigment (col. 3, lines 25 and 30).

Regarding claim 15, Takahashi et al. disclose the solid pigment can be used in coloring plastic and powdery paint (col. 8, lines 1-4). They also disclosed that the pigment and resin could be mixed through hot kneader, extruder and a hot miller (col. 1, lines 19-22)

Regarding claim 16, Takahashi et al. disclose a solid pigment comprising of 1-70% of pigment (col. 4, lines 9 and10) and 27-96% at least one ethylenically unsaturated polymerisable compound (col. 3, lines 22 and 23) and 3-60% a resin (col. 3, lines 49 and 50).

When applicants contends that the modifying components in the reference are excluded by the recitation of "consisting essentially of", applicants have the burden of showing the basic and novel characteristics of their composition – i.e. A showing that the introduction of these components would materially change the characteristics of the applicants' composition. In re Delajarte, 337 F 2d 870, 143 USPQ 256 (CCPA 1964).

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over U. S. patent No. 4,234,466 to Takahashi et al., in view of U. S. Patent No. 5, 112,404 to Sommer et al.

Regarding claim 9, Takahashi et al. disclose a pigment composition as applicant set forth in claim 1, but they are silent about the nonionic surface active additives based on polyether used in the composition.

However, it would have been obvious to one of ordinary skill in the art at the time of invention by applicant to use polyether based surface-active additive in the teaching of Takahashi et al., motivated by the fact that Sommer et al., also drawn to pigment preparation, disclose that It is advantageous to use surfactant such as alkoxylation product of alkylphenols, fatty amine and et al. in an amount of 0-20%, in particular in an amount of 0-10% based on the weight of the pigment in the pigment preparation (col. 9 line 66 to col. 10. line 25).

(10) Response to Argument

The applicant argues that Takahashi et al. fail to disclose that the solid pigment composition comprising at least one water soluble anionic surface active agent (component B). The Examiner respectfully submitted that this is not persuasive because

the reference clearly teaches a composition made up of (1) a pigment and (2) a polymer or copolymer of ethylenically unsaturated monocarboxylic acid.

The applicant argues that the ethylenically unsaturated polymerisable compound of prior art is not component B as applicant claimed in the instant application, namely is not a water soluble anionic surface active. The Examiner respectfully submits that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. The Examiner respectfully submits that the applicant does not provide any factual evidence to show that the ethylenically unsaturated polymerizable polymer in the resin matrix is not water soluble.

The applicant argues that the solid pigment of Takahashi et al. is free any compound (B) since the prior art disclose the washing step. The Examiner respectfully submits that the surface of the free ethylenically unsaturated polymerized polymer may be washed out, but how about the compound in the resin matrix? The teaching of the Takahashi et al. meets the limitation of claim 1. The Examiner respectfully submits that the applicant does not provide any factual evidence to show that the ethylenically unsaturated polymerizable polymer in the resin matrix is not component B. The claim 1 recites no limitation that the ethylenically unsaturated compound must be present on the surface of the pigment.

The applicant argues that the preparation process is different. The instant application using spray drying apparatus. The Examiner respectfully submit it is noted

that the features upon which applicant relies (i.e., spray drying) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The applicant argues that there is nowhere in prior art disclose that size and the surface area. The Examiner respectfully submits that Takahashi et al. disclose a solid pigment comprising a titanium dioxide pigment having bead particle in the range of 0.1-0.5 mm (col. 8, lines 36 and 37). Although they are silent about the surface area as applicant set forth in claim 2, it is the position of the Examiner that the surface area of a particle is the function of the size and shape of the particle, the claimed surface area would be necessary followed from the teaching of Takahashi et al.

The applicant argues that anionic surfactant is optional in the teaching of Sommer. The Examiner respectfully submits that "optional" means the surfactant can be used in the composition. While the reference does not provide a specific example which falls within the instant claims, it should be noted that "A reference can be used for all it realistically teaches and is not limited to the disclosures in its specific examples". See *In re Van Marter et al* 144 USPQ 421; *In re Windmer et al* 147 USPQ 518, 523; and *In re Chapman et al* 148 USPQ 711.

Applicant argues that Sommer et al. and Takahashi et al. are not combinable. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is

some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the Examiner respectfully submits that Sommer et al. disclose that it is advantageous to use surfactant such as alkoxylation product of alkylphenols, fatty amine and et al. in an amount of 0-20%, in particular in an amount of 0-10% based on the weight of the pigment in the pigment preparation (col. 9 line 66 to col. 10. line 25). In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Regarding claim 12 and 14, the applicant argues that the Takahashi fail to disclose the process as applicant set forth in the instant application. The Examiner respectfully submits that Takahashi et al. disclose an ethylenically unsaturated polymerisable compound, a resin and a pigment mixed by a conventional dispersing machine such as roller mill, a colloid mill, a fluid energy mill, an oscillation ball mill, and ball mill and then dried to obtain solid pigment(col. 4, lines 16 – 22 ;Example 1).

Since the rejection for the claim 7 is valid, the rejection of claims 13 and 15 stands. Takahashi et al. disclose that the solid pigment is incorporated by stirring (col. 8, line 33).

Regarding claim 16, the applicant contends that the modifying components in the reference are excluded by the recitation of “consisting essentially of”, applicants have the burden of showing the basic and novel characteristics of their composition – i.e. A showing that the introduction of these components would materially change the characteristics of the applicants’ composition. In re Delajarte, 337 F 2d 870, 143 USPQ 256 (CCPA 1964).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner’s answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Shuangyi Abu-Ali/

Examiner, Art Unit 1793

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/Christopher A. Fiorilla/

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